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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,527	03/10/2004	Roger M. Bernsen	5265.3813	2526
22235	7590	03/23/2007	EXAMINER	
MALIN HALEY AND DIMAGGIO, PA			LAVINDER, JACK W	
1936 S ANDREWS AVENUE			ART UNIT	PAPER NUMBER
FORT LAUDERDALE, FL 33316			3677	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/708,527	BERNSEN, ROGER M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jack W. Lavinder	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 December 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 4 and 5 is/are allowed.  
 6) Claim(s) 1 and 3 is/are rejected.  
 7) Claim(s) 2 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____.                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 3 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rochas, 1712171 in view of Driggott, 1182534.

Rochas discloses a temporary setting for a gemstone to allow the gemstone to be interchanged with other gemstones when the wearer decides to change the stone. The setting includes a cylindrical spring (b, figures 1-3) hinged to the setting for closing on the bottom of a gemstone to resiliently hold the gemstone in permanently in place (page 1, lines 55-84) until the wearer decides to change the stone. The setting also includes an inside bezel including a narrowed conically circular shaped passage (a1, figure 4) with a diameter smaller than the diameter of the gemstone to prevent the passage of the gemstone through the top of the setting.

The claims call for an opening provided in the cylindrical sidewall of the spring. Rochas fails to disclose this limitation. However, Driggott discloses a slit (figure 3) in the sidewall of the cylindrical spring (10) in order to improve the amount of force the spring places on the setting to hold the gemstone in place. It would have been obvious to a person having ordinary skill in the art to place of slit opening in a slightly enlarged cylindrical spring in Rochas's setting in order to improve the retention force of the spring

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to prevent the unwanted opening of the spring and the subsequent loss of the gemstone.

With regard to the use of the term "permanent" in the claims, Rochas and Driggott both disclose settings that are "permanent" until the wearer decides to change the gemstone. The limitation "permanent" is considered to be met, because as long as the wearer desires to have a certain stone in the setting, the springs in both Rochas and Driggott will permanently hold the stone in the setting. This is exactly the same with all "permanently" set stones. For instance, a diamond set in a ring is considered permanent until the diamond fails out of the setting or the wearer decides to change the diamond. Therefore, the term permanent is considered to be a relative term of degree (nothing is really permanent) and for this reason Rochas and Driggott as described previously meets this limitation.

***Allowable Subject Matter***

3. Claim 2 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 4 and 5 have been allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jack W Lavinder  
Primary Examiner  
Art Unit 3677

12/28/2006